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IN THE

Supreme Court of the United States

OCTOBER TERM, 1930.

No. 51.

SARANAC AUTOMATIC MACHINE CORPORATION,
Petitioner,

v.

WIREBOUNDS PATENTS COMPANY and 4-ONE BOX MACHINE MAKERS,
Respondents.

RESPONDENTS' REPLY TO PETITIONER'S SUPPLEMENTAL BRIEF

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TABLE OF CONTENTS.

	PAGE
Introduction	1
Respondents' Answer to Petitioner's Statement that Inwood and Lavenberg Employed Two Machines in Their Blank-Making Operation	2
Subordinate Points in Petitioner's Supplemental Brief Calling for Correction	6

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TO THE HONORABLE THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

May it please the Court:

Petitioner has tendered a supplemental brief. If that is to be filed, the following reply by Respondents should be received to correct Petitioner's misleading treatment of an important aspect of the case.

In Petitioner's supplemental brief (page 2), exception is taken to Respondents' assertion that its inventors, Inwood and Lavenberg, taught the art how to substitute a *single* machine for the *two* machines of the Rosback prior art practice. Petitioner says (*ibid.*):

> "This is erroneous, as Inwood and Lavenberg, in the patent in suit, must employ a step-mitering machine, and must employ two machines."

This argument ignores the important facts that (1) if it is material that Inwood and Lavenberg used a conventional wood-working machine for preliminarily preforming cleats, and therefore can be said to have employed *two* machines,—it is equally material (2) that Rosback necessarily used conventional wood-working machinery for preparing the long cleat strips which were subsequently operated upon first by the Rosback blank machine and then by the Rosback step-mitering machine, and therefore Rosback employed at least *three* machines.

In Respondents' main brief, in contrasting the Rosback *two*-machine practice with Inwood and Lavenberg's novel *one*-machine practice, the argument concerned itself simply with the two machines, or the single machine, employed in making the *box blanks* from the previously prepared wooden elements. It is undeniably true that for making *box blanks*, Rosback always used the *two* machines,—one for making the rigid blank, and the second for severing and step-mitering the cleats and scoring the side-material, —while Inwood and Lavenberg used but a *single* machine.

If, however, as Petitioner now suggests, we should go back to the wholly preparatory wood-working operations that preceded the box-blank making, then this necessarily draws into consideration an additional preliminary machine used in the Rosback practice and also in the Inwood and Lavenberg practice. By this method of analysis, Rosback is found to have used at least three machines, while Inwood and Lavenberg used two.

Rosback's pair of long cleat strips, that became incor-

porated in each rigid blank, were not products of nature; they were required to be sawed and finished to accurate cross-sectional dimensions and to approximately correct length, and for these purposes wood-working machinery was employed. This had to be done before the cleat strips were introduced to what Respondent has called the Rosback first machine for making the rigid blank. But, according to Petitioner's discussion, the conventional wood-working machinery for preparing the cleat strips should be reckoned the first machine in the series. Still the Rosback blank machine and then the step-mitering machine had to be called upon before the Rosback foldable blank could be made. Hence, in all, the Rosback practice, as described by Petitioner, involved at least three machines.

In the Inwood and Lavenberg practice, the individual preformed cleats had to be made to cross-sectional dimensions and lengths, and their ends were appropriately shaped by step-mitering or otherwise. For these purposes, conventional wood-working machinery was used. One such machine is shown in the picture opposite page 3 of Petitioner's supplemental brief. All such wood-working machinery was well known in the prior art and would have been available to the Rosback inventors at any time, if they had perceived the practicability of using them. The Rosback inventors used a corresponding wood-working machine to prepare their long cleat strips.

But, as sharply contrasted with the Rosback practice, Inwood and Lavenberg's preformed cleats (with whatever side material) needed to be assembled and wired together on only a *single* blank machine in order to produce the completed foldable blank. Hence, even according to Petitioner's argument, it remains true that Inwood and Lavenberg

employed but the *two* machines as compared with Rosback's *three*.

If it would serve any useful purpose, we could go clear back to the standing tree which was to be converted ultimately either into Rosback's cleat strips or Inwood and Lavenberg's preformed cleats. We could point out that the standing tree must be felled, in either event, by like saws or axes; that the resulting log must be sawed into planks upon like sawmills, and the planks then re-sawed to produce strips of proper transverse dimensions. Then, in each case, these strips of indeterminate length, must be cut across to produce the proper lengths for the respective long cleat strips or preformed cleats.

Up to this point, the background of the Rosback practice involved machinery exactly corresponding to that used in the background of the Inwood and Lavenberg practice, with the sole exception that one commonplace species of cutter (perhaps a circular saw) was used for forming the square ends of Rosback's cleat strips, while another species of equally commonplace cutter was used for forming the ends of Inwood and Lavenberg's preformed cleats. Throughout these merely preparatory processes, the same number and the same character of conventional wood-working apparatuses were called for.

Thereafter, however, there was a wide divergence in the mechanical expedients employed by the Rosback inventors, on the one hand, and Inwood and Lavenberg (*and Petitioner*) on the other hand. In making *box-blanks*, Rosback used the complex *two*-machine practice, while Inwood and Lavenberg (*and Petitioner*) produced the finished blank on a *single* machine.

Thus, however Petitioner may quibble upon the number of machines which should be mentioned in contrasting the

Rosback with the Inwood and Lavenberg operations, it nevertheless remains true that Rosback required the use of *one additional* and extremely complex machine, while Inwood and Lavenberg taught the art how to obviate the need for that additional machine.

Petitioner's discussion implies that the step-mitering machine used in making Inwood and Lavenberg's preformed cleats, was comparable with the Rosback step-mitering machine employed for severing and step-mitering the cleats, and scoring the side-sheet of the Rosback rigid blank. But the two machines were not at all comparable as to either the complexity of their mechanisms and functions or their practical efficiency. Inwood and Lavenberg's cleat-making dealt simply with small individual pieces of wood acted upon by commonplace cutters of long-recognized character and efficiency. The Rosback step-mitering machine required five different sets of saws and five sets of cutters (see patents, R. pp. 1426, 1428), adjusted in accurate relationship, to produce at a single operation eight cleats, four in each row, and three scores marking off the side-material into four box sides. The unwieldy rigid Rosback blank was a very different thing to deal with mechanically, from Inwood and Lavenberg's small individual cleats.

The Rosback inventors had before them continuously both the complex gang step-mitering machine for converting the rigid into the foldable blank, and also the conventional step-mitering machines of the general wood-working arts (see Petitioner's admission, Supplemental Brief, p. 7, p. 26). But it never occurred to them to use the latter for preforming cleats, instead of resorting to the former as the *second* machine essential to their *blank-making* cycle.

It appears, therefore, that Petitioner is merely juggling words, without the slightest effect in substance, when it

asks to include the consideration of preliminary woodworking machinery, when comparing the Rosback with the Inwood and Lavenberg practices. The fact remains, inescapably, that, starting with pre-determined forms of wooden elements (cleat strips or cleats, and some form of side-material), Rosback's *blank-making* cycle essentially required *two* machines, and Inwood and Lavenberg's required only *one*. And by this difference, Inwood and Lavenberg succeeded in avoiding that "impossibility of automatic or partly automatic production" which had always defeated the Rosback inventors, as pointed out by Judge RAYMOND. Upon that difference between the *two*-machine and their *one*-machine practices, Inwood and Lavenberg taught the art how to establish a successful industry.

Other subordinate points made in Petitioner's supplemental brief call for correction.

For instance (page 12), there is a badly garbled quotation from the Record referring to R. Vol. II, page 801. As Petitioner's supplemental brief has it, the quotation is thus:

> "A. Well, the Rosback box when completed was not a commercial box. It was a box we could not sell." (R. Vol. II, p. 801).

As the text actually occurred at the place cited, it is as follows:

> "A. Well, the Rosback box when completed was not a commercial box. It was a box we could not sell, for the reason—[then an interruption by examining counsel].
>
> "Q. I am not asking you for difference in the commercial character of the boxes, but for difference in the construction.

"A. Well, the construction of the blank in practice was different for this reason, that in the Healy or Rosback box when folded the corners *sometimes*, some of the corners on one box would be round at one end and out clear through making a hole at the other end. This could not be regulated *on the Rosback machine* so that this would not occur, and if the grain of the wood was not exactly paralleled to the cut it would make the corners splintered. In our box the corners were perfect."

Thus (although Petitioner did not see fit to indicate the fact) Mr. Inwood gave a *reason* for the difficulty with the Rosback box, namely, its defects

"Could not be regulated on the *Rosback machine*."

As to Petitioner's second quotation from Mr. Inwood's testimony (supplemental brief, page 12) reference is made to "the objections to the box which we were making or trying to make".

There were objections to the box for some purposes. Nevertheless, in the suit in which Mr. Inwood testified, and after all the testimony was in, it was found by the Master (and no exception to the finding was ever taken by any party) that the Rosback box, *per se*, was a commercial box. The Master's finding to this effect is quoted and explained in the "Appendix to Respondents' Brief" (page 12).

If there is any difficulty on the score of the commercial character of the Rosback box, the Court is invited to read the pertinent parts of the Appendix to Respondents' Brief (page 12 *et seq.*; page 19 *et seq.*). The undisputed evidence makes it clear that the Rosback box was entirely practical, and that the difficulties in the prior art were precisely as stated by Judge Raymond, namely, "the impossibility of

automatic or partly automatic production". The Rosback inventors could not devise usable machines. Inwood and Lavenberg contributed the first successful machine, covered by the patent in suit.

In attempting to explain why Rosback did not employ preformed cleats, Petitioner's supplemental brief (page 26) makes a flagrant misstatement of fact. There it is said that:

> "* * * Rosback employed a peculiar construction for his box, which construction *precluded the use of preformed cleats.*"

Petitioner vouchsafes no explanation for this statement, nor any citation to supporting evidence. In fact, the statement is untrue.

As pointed out in the Appendix to Respondents' brief (page 38), the very first use of Inwood and Lavenberg's former or workholder for positioning preformed cleats was devoted to the production of precisely the Rosback foldable blank having the continuous sheet of scored veneer side-material; and this occurred some weeks before the lap-corner box, having the separate side sheets, was even invented.

The extravagance of Petitioner's misstatement is best indicated by an explicit finding of the Master in the old Healy title suit in which Mr. Inwood and various others testified. As developed in the historical narrative in the Appendix to Respondents' Brief, Inwood and Lavenberg's machine for wiring the preformed cleats came into use in early July, 1904. The Master found (Record, Vol. I, page 453):

> "About 800 sample boxes, both creased [*i. e.*, the Rosback veneer box] and lapped [*i. e.*, the Inwood and

> Lavenberg lap-corner box], were made before August 31, 1904, by the South Bend Healy Box Company, and sold to a consumer in South Bend, Indiana, who used them in his business."

And this was during a period when the Inwood and Lavenberg preformed cleat practice was in use *exclusively*.

Thus it is clearly established that Rosback boxes were in fact made by the Inwood and Lavenberg preformed cleat practice, and were then sold commercially.

As further evidence of the fact that the Rosback bent veneer box was made starting with preformed cleats, Inwood on July 11, 1904 (a few days after the invention of the lap corner box), wrote to Healy (R. Vol. II, p. 727) as follows:

> "In reply to yours of the 10th inst., we are sending you by express a small Russ box made on the new step-mitre and former. In this box the tops and bottoms are lapped instead of being creased and folded. You can look the box over and kindly write us as to your opinion on making the box this way. *We can make them either way*, but the sample sent you saves one step in the manufacture, viz.: the cutting of the crease and as the corners are always square, it adds to the appearance of the box."

This shows that either the Rosback bent veneer blank or the Inwood lap corner blank could be made by preforming and assembling the cleats in the newly invented workholder or "former". The "new step-mitre" referred to in Inwood's letter was the simple machine for preforming the cleats, and must not be confused with the old complex Rosback step-mitre machine for use with the rigid preliminary blank.

And prior to the production of the lap-corner box,

Inwood had written to Healy under date of July 8, 1904 (R. Vol. II, p. 726) as follows:

> "The *new* step-mitre [for preforming individual cleats] is working nicely and we are now making the small Russ box on the former [workholder]. This appears to be the best way of making the box and according [to] the prices received at this date will reduce the cost of cleat lumber from $20.00 per M to about $5.00, and I think will give us a better made box. The work of the next few days will determine this beyond doubt."

This "small Russ box" mentioned by Mr. Inwood was the Rosback bent veneer box. Mr. Russ himself described the purchase of the bent veneer boxes from Inwood's company (R. Vol. II, p. 875), and then says (R. Vol. II, p. 876) as follows:

> "*Subsequently* to the purchase of these boxes we purchased *another type* from the South Bend Healy Box Corporation. *That was later on in the fall of the year 1904* and the years following. Our heaviest shipments begin about September 1st and run from September 1st to November 15th or the first of December. We made this *second* purchase of the *other* type of box at the beginning of our busy season, *about the first of September, in 1904.* The box that we purchased from the South Bend Healy Corporation in September, 1904, was a rectangular box made of veneer. The ends were step-mitred with a narrow cleat and when the box was folded the tops and bottoms *fitted over the sides* and made a complete box (the lap corner box)."

Since Russ began to receive these lap-corner boxes only in September, 1904, it follows that "the small Russ box" which Inwood was making on the "former" on July 8, 1904, was the earlier bent veneer box.

Thus it is clearly established that the Rosback box was in fact made by the Inwood and Lavenberg preformed cleat practice, and that the peculiar construction of the Rosback box did not *preclude* the use of preformed cleats, as stated by Petitioner.

At any time in the history of the Rosback inventors, they could have made their box by the preformed cleat practice, if only they could have avoided the "impossibility of automatic or partly automatic production", *i. e.*, if only they could have invented Inwood and Lavenberg's machine of the patent in suit.

Respectfully,

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